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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,712	01/18/2002	Donald R. Glynn	DWE/GLYNN2	6321

7590 10/19/2004

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EXAMINER

MENON, KRISHNAN S

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 10/050,712	Applicant(s) GLYNN, DONALD R.	
	Examiner Krishnan S Menon	Art Unit 1723	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 October 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☒ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: attached.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

Attachment to PTOL 303: Advisory Action

After final Amendment of 10/1/04 cannot be entered because amended claim 12 contains the new matter, "double pipe", which has no supporting disclosure in the application as originally filed. Applicants' invention according to Fig 5 and the specification page 4 is a multiple-lumen ceramic filter element (76) installed concentrically in a pipe (74), which is not a double-pipe, because a double-pipe as in a double-pipe heat exchanger, is a pipe installed coaxially in another pipe, and a pipe as commonly known, is a single-bore hollow cylinder. The ceramic membrane of the present invention does not fit this description.

"Double-pipe" is also a new issue requiring new consideration and search.

Response to Arguments:

Applicants' request for reconsideration of the finality of prosecution: The last office action (second office action) was made final, even though there were new grounds for rejection. This was because applicants had amended the claims in response to the first office action, which required new search and resulted in new grounds for rejection. The finality of the action is, therefore, appropriate. See MPEP 706.07(A).

In response to the arguments against the Falletti ref: Applicants argue that claim 12 defines the present apparatus as "apparatus for retrieving reusable water from an intimate water/oil –contaminated mixture ...". This recitation of the claim is from the preamble and at best is intended use, which is not a patentable limitation. A claim

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containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987)

In response to the limited collection space: this limitation was addressed in the rejection. In addition, the volume of the collection space is within the ability of one of ordinary skill in the art to optimize for engineering tolerances for assembly vs. minimizing flow space. Discovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art. In *re Boesch and Slaney*, 205 USPQ 215 (CCPA 1980); In *re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977); "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In *re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955)

In response the addition of the new term "double-pipe": during the discussion, the examiner only used the term in his query about the structure of the filtration system ("is it a double-pipe, like in a double-pipe heat exchanger?"), and there was no suggestion by the examiner to use it to amend the claim. Upon review of the specification, the examiner finds that there is no support in the specification for using that term in the claim.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S Menon whose telephone number is 571-272-1143. The examiner can normally be reached on 8:00-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Krishnan Menon
Patent Examiner


W. L. WALKER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700